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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KERRY BRADLEY

Appeal 2015-003711
Application 13/958,345[1]
Technology Center 3700

Before MICHAEL C. ASTORINO, ROBERT L. KINDER, and ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–21. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] The Appellant identifies Boston Scientific Neuromodulation Corporation as the real party in interest. Appeal Br. 2.

ILLUSTRATIVE CLAIM

1. A method for treating a patient requiring conditioning one or more muscle groups using at least one electrode implanted within a ventral epidural space of the patient, the method comprising:

conveying electrical stimulation energy from the at least one implanted electrode to motor efferents respectively innervating the one or more muscle groups, thereby activating the one or more muscle groups.

CITED REFERENCES

The Examiner relies upon the following references:

Kidd et al. (hereinafter "Kidd")	US 4,712,558	Dec. 15, 1987
Powell, III et al. (hereinafter "Powell")	US 5,358,513	Oct. 25, 1994
Meadows et al. (hereinafter "Meadows")	US 2003/0120323 A1	June 26, 2003
Anderson	US 2007/0150036 A1	June 28, 2007
Kuzma et al. (hereinafter "Kuzma")	US 2007/0168007 A1	July 19, 2007

REJECTIONS

I. Claim 1 is rejected under 35 U.S.C. § 112(b),[2] as failing to point out and distinctly claim the subject matter that the Appellant regards as the invention.

[2] The Examiner rejects claim 1 under either 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph. Final Action 4. Because the Appellant's application was filed after September 16, 2012, the AIA version of the statute is applied herein. *See* MPEP § 2161(I).

II. Claims 1–3, 5–9, 14, 15, and 19–21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Meadows and Anderson.[3]

III. Claims 4 and 10–12 are rejected under 35 U.S.C. § 103(a) as unpatentable over Meadows, Anderson, and Powell.

IV. Claim 13 is rejected under 35 U.S.C. § 103(a) as unpatentable over Meadows, Anderson, and Kuzma.

V. Claims 16–18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Meadows, Anderson, and Kidd.

FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

ANALYSIS

Rejection Under 35 U.S.C. § 112(b)

According to the Final Office Action (page 4), claim 1 fails to provide sufficient antecedent basis for the limitation "the one or more muscle groups."

In response, the Appellant argues that the recitation of "one or more muscle groups" in the preamble of claim 1 provides such sufficient antecedent basis. Appeal Br. 4.

We agree with the Appellant, because the use of the expression "one or more muscle groups" in the preamble may provide antecedent basis for

[3] Although the Examiner sets forth separate statements for the rejection of claims 1–3, 5–9, 14, and 15 (Final Action 4–5) and the rejection of claims 19–21 (Final Action 8), both rejections are based upon the same combination of prior art references, i.e., Meadows and Anderson. As such, we have consolidated these statements into a single ground of rejection.

the same expression referenced in the body of the claim. *See Pacing Techs., LLC v. Garmin Int'l, Inc.*, 778 F.3d 1021, 1024 (Fed. Cir. 2015).

Accordingly, the rejection of claim 1 under 35 U.S.C. § 112(b) is not sustained.

Rejection Under 35 U.S.C. § 103(a)

The Appellant argues that the cited Meadows reference lacks the following feature of independent claim 1 (emphasis added):

> using at least one electrode implanted within a ***ventral epidural space*** of the patient . . . conveying electrical stimulation energy from the at least one implanted electrode to motor efferents.

See Appeal Br. 5–6; Reply Br. 1–3.

The Examiner takes the position that Meadows' teaching of inserting an electrode "into the epidural space" (a region surrounding the spinal cord) encompasses such an insertion into both the dorsal epidural space (behind the spinal cord and toward the patient's back), as well as the claimed "ventral epidural space" (in front of the spinal cord). Answer 6 (citing Meadows ¶ 79). According to the Examiner, the Appellant's Specification reinforces the notion that the general reference to "epidural space" includes both its dorsal and ventral portions, by stating that "[t]he epidural space 128 may be topologically divided into two halves: a ventral epidural space 128a and a dorsal epidural space 128b." *Id.* (citing Spec. ¶ 36[4]).

According to the Appellant, Meadows teaches the use of an electrode in epidural space, generally, but not in the claimed "ventral" epidural space,

[4] The Examiner refers to ¶ 37 of the published application, US 2014/0039574 A1 (pub. Feb. 6, 2014). Answer 6. This Decision refers to the version of the Specification dated August 2, 2013, wherein the text quoted by the Examiner appears at ¶ 36 thereof.

specifically. Appeal Br. 6; Reply Br. 1–2. Further, the Appellant contends that Meadows teaches no more than providing stimulation to the dorsal epidural space (Reply Br. 2 (citing Meadows ¶ 4)) — a technique that the Appellant characterizes as conventional (*id.* (citing Spec. ¶ 38)) — "[h]owever, locating electrodes in the ventral epidural space for stimulating efferent fibers in the manner of claim 1 is unmentioned in the cited art" (*id.*).

The Appellant's arguments are persuasive of error in the rejection. The Examiner's position is that Meadows' general disclosure of an electrode in epidural space "discloses" or "includes" (Answer 6) the more specific disclosure of the unidentified ventral epidural space. Yet, such specificity is lacking in the cited portions of the reference, which do not mention the "ventral" epidural space. *See* Meadows ¶¶ 3–4, 79. Accordingly, the rejection of claim 1 (and claims 2–21 depending therefrom) under 35 U.S.C. § 103(a) is not sustained.

DECISION

We REVERSE the Examiner's decision rejecting claim 1 under 35 U.S.C. § 112(b).

We REVERSE the Examiner's decision rejecting claims 1–21 under 35 U.S.C. § 103(a).

REVERSED